

REMARKS

This is in full and timely response to the above-identified Office Action. The claims remain as they were amended in the response submitted on February 20, 2004. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Claim Status

Claims 1-19 stand provisionally rejected for double patenting; and
Claims 1-19 stand rejected under 35 USC § 103.

Double Patenting

The provisional double patenting rejection is traversed. The independent claims in USN 09/925,649 in fact differ from those pending in the instant application at least the claims in USN 09/925,649 require a request for authorization and a detection of receipt of the authorization. Merely by way of example, claim 1 of USN 09/925,649 is as follows:

A printing method, comprising the steps of:
receiving data at a printer;
detecting a network address in the received data;
if a network address is detected, then **displaying or sending a message notifying of the network address detection** and requesting authorization to access the network address;
if authorization to access is received, sending on the Internet or other network an access request for a document to the network address;
retrieving the document from the network address; and
printing the document. (Emphasis added)

On the other hand, claim 1 of the '650 application calls for:

A printing method, comprising the steps of:
receiving data adapted to contain a network address, at a printer;
determining whether a URL or external network option is enabled;
detecting if a network address is in the received data;
sending on the Internet or other network an access request for a document to the network address;
retrieving the document from the network address; and
printing the document. (Emphasis added)

It is submitted that the claims in the '650 application and those pending in USN 09/925,649 are different to the degree that any question of double patenting is rendered moot.

For example, the independent claims of the '650 application require a determination if a URL or external network option is enabled, while the independent claims of '649 do not. The independent claims of this application ('649) require that if a network address is detected, then a message is either displayed or sent notifying of the network address detection. These claims further require a request for authorization to access the network address to be included in this message. The independent claims of '650 application do not contain these latter mentioned limitations and therefore do define the same subject matter nor subject matter which would be obviously .

It is again submitted that this issue can only be effectively resolved when the claims in both applications are allowed and/or in condition for allowance and a comparison of the claims is meaningful. It is additionally pointed out that '649 and '650 were filed on the same day. This further renders both the effect and need for a terminal disclaimer, moot.

M.P.E.P. Section 1504.06:

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public

policy so as to prevent the unjustified or improper **timewise extension** of the right to exclude granted by a patent. In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). (Emphasis added)

It is also submitted that it is irrelevant that the same subject matter is “disclosed” in USN 09/925,650. What is relevant is whether the claimed subject matter is the same in the two applications.

Further, the argument that there is no apparent reason why the applicant would be prevented from presenting claims corresponding to those of the instant application in the USN 09/925,650 is without merit. What may potentially be done is irrelevant until it comes into existence and a factual claim situation is realized.

Rejections under 35 USC § 103

- 1) The rejection of claims 1-10, 13-14 and 18-19 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Russell et al., is respectfully traversed.

The position taken in this rejection is clearly based on the erroneous assumption (see page 6, lines 1-2 of this Office Action), that the integration of the scanner and the printer in Tabata et al. into a single device does something more than enclose the two devices in single housing arrangement. It is pointed out that the Tabata et al. reference continuously describes the printer and the scanner as separate elements and assigns each different numerals throughout the document. It is clear that the printer still functions as the printer and the scanner as the scanner. Indeed, why, if the printer and the scanner have integrated to the degree purported in this rejection, is there not just one numeral for both devices?

Attention is also called to the fact that this rejection is made under the § 103 statute as different from the § 102 statute wherein the indication of “integration” could possibly be extrapolated to the sublime/ridiculous and the influence on the hypothetical person of ordinary skill of the disclosure taken as a whole, could be blithely ignored.

It would be nothing short of revolutionary for a printer to be able to scan and for a scanner to be able to print. However, there is nothing in Tabata et al. that would suggest that this is in fact possible and – as pointed out above – the scanner is constantly referred to as the **scanner unit 430** and the printer as **printer 460**. This repeated disclosure of the printer and the scanner as being separate elements would clearly have an effect on the hypothetical person of ordinary skill's understanding of what is meant the the disclosed “integration” of these elements.

That is to say, the “integration” does not change the function of individual devices and merely places them in fixed close proximity to one another. The all encompassing reliance on the “integration” disclosure is misplaced. Indeed, there is nothing in the rejection which would show that the integration is anything more than enclosing the two devices in the same housing and thus the rejection must be seen as being totally untenable.

In order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be able to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered as statutorily required. It is submitted that the rejection as advanced in this rejection fails to make this showing.

While redundant and unnecessary in light of the basic flaw in the formulation as noted above, the argument advanced in the last response is repeated. More specifically:

IN TABATA ET AL. PRINTER AND SCANNER ARE DIFFERENT DEVICES

The Tabata et al. reference, at column 23, lines 10-12, discloses that a copying machine 470 comprises a scanner unit 470A as a “correlated information identifying unit” and a printer 470B as an “output unit” and that the two units are “integrated” into one device (viz., the copying machine 470). It is submitted that this reference discloses

throughout the document that the scanner and printer are, irrespective of the integration, different devices, and that this disclosure would cause the hypothetical person of ordinary skill to understand that the fact the integration of the two into a single arrangement does not suggest that the scanner is a printer or *vice versa*.

TABATA ET AL. PRINTER DOES NOT RECEIVE ADDRESS CONTAINING DATA

It is submitted that the disclosure of column 23, lines 56-63, which is relied upon to disclose the first of the steps set forth in claim 1, does not disclose the printer receiving any data. In fact, this section indicates that it is the scanner unit that reads the medium and reads a code area 206 which is on the medium as raster information. More specifically, column 23, lines 56-63, discloses:

Then, the medium form 420 with the **mark(s) 51** added thereto is **read by the scanner unit** (correlated information identifying unit) 430 or 470A (S2101). In this case, each of the **scanner units 430, 470A reads a code area 206 from the medium form 420 as raster information** and also reads a text section with the mark(s) 51 added thereto. With those operations, linkage information and selection information are supposed to be read.

It is therefore clear that if data, which contains an address, is “received”, it is disclosed as being “received” by the scanner and not the printer. This disclosure can be seen as teaching away from the claimed subject matter.

Thus, in a nutshell, the claims call for the printer to receive data which can include certain information such as network address. Tabata et al. teaches the use a scanner which is associated with a printer to receive data inputs, and therefore leads the thinking of hypothetical person of ordinary skill away from using the printer for this purpose. In fact, the disclosure of the Tabata et al. is such as to lead the thinking of the

hypothetical person of ordinary skill in the direction that the printer is to be used for just printing and is provided printing information from a server.

CLAIMED REQUEST FOR AUTHORIZATION IS TRIGGERED BY NETWORK ADDRESS IN
DATA RECEIVED BY PRINTER - NOT SCANNER

The independent claims of this application call for an operation wherein if a network address is detected, then a message is either displayed or sent notifying of the network address detection, which requests authorization to access the network address.

Column 24, lines 18-23 are asserted as disclosing the step of sending on the internet an access request for a document to the network address. The rejection does however, acknowledge that Tabata et al. does not "clearly" disclose requesting "authorization" to access the network address and turns to Russell et al. to overcome this admitted shortcoming in disclosure.

However, this section of Tabata et al. discloses:

The file **server** (correlated information file retrieving unit) 440 **retrieves**, when having received an address (URL) of the correlated information file, **an appropriate correlated information file** from the appropriate file device 410 according to the address (URL) of the correlated information file (S2103).

The file **server** transfers the retrieved correlated information file to a **printer 460** or to a printer **470B** (S2104). (Emphasis added)

Thus, in response to being supplied an address from a **scanner** unit, the server retrieves the file and then sends it to the **printer**.

PASSWORD WOULD NOT BE OBVIOUS IN CLAIMED ARRANGEMENT

The rejection takes the position that using a password in Tabata et al., and sending this password to a remote administration location would have been obvious at the time of invention in that it would have improved the securing of the system. However, when one considers the concept on which Tabata et al. is based, it is clear that the only way into the system is through a scanner which scans a medium, sends the information derived from the scanning to a file server which is triggered to send the appropriate print instructions to the printer. If there is to be a password it would have to be incorporated into the medium 210 and the scanner 60 (see Fig. 1) adapted to refuse to scan/transmit if the password was not provided. In this connection the teachings of Russell may be consulted. However, the use of the teachings of Russell et al. would mean that the printer would never be able to respond to this type of password and it would always have to be the scanner which performs this function. The claimed invention, therefore could not be arrived at through the transfer of teachings.

- 2) The rejection of claims 11 and 12 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Russell et al and further in view of Wolff, is respectfully traversed.

It is submitted that the teachings of Wolff would not overcome the tendency for the teachings of Tabata et al. and Russell et al. to move the thinking of the hypothetical person of ordinary skill, away from the claimed subject matter. Indeed, Wolff has been cited only to overcome the admitted shortcoming that Tabata et al. does not disclose/suggest the receipt of data via e-mail.

It is submitted that the system of Tabata et al. does not lend itself readily to internet access and, as noted above, is basically dedicated to scanning data off sheets of medium such as paper, and feeding the data thus obtained to a server for further action such as printing. As noted above, the teachings of Russell et al are such as reinforce this tendency. Hence, the citation of Wolff does not clarify matters and, in fact, is such as to add confusion as to how an e-mail connection could be introduced

into the arrangement disclosed in Tabata et al. without inducing a departure from the basic intentions of Tabata et al.

This rejection is deemed untenable, and is traversed for at least this reason.

- 3) The rejection of claims 15-17 under 35 USC § 103(a) as being unpatentable over Tabata et al. in view of Russell et al and further in view of Wolff, is respectfully traversed.

In this rejection, Wolff has been cited only to overcome the admitted shortcoming that Tabata et al. does not disclose printing one document in another and identifying the contents of the documents. It is submitted that even if (*arguedo*) such a feature were to be introduced into the arrangement of Tabata et al. still the data would suggested as being received at the printer and as such the claimed subject matter would not be rendered unpatentable.

Conclusion

It is submitted that the claims are allowable over the art for at least the reasons advanced above. Favorable reconsideration and allowance of the claimed subject matter is courteously solicited.

Respectfully submitted

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